

## REMARKS

Claims 1-27 are pending in the application. All claims stand rejected under 35 USC §101 because the claimed invention “is not supported by either a specific and substantial utility or a well established utility (i.e.: an electronic mail client does not specify as a method, apparatus, system, [or] computer readable medium.”

Claims 1-7 were originally drawn to “an electronic mail client”. These claims have been amended to read “an electronic mail client system”. It is believed that the amendment to claims 1-7 overcomes this rejection.

Claims 8-13 were originally drawn to “an electronic mail system” and it is therefore believed that they already overcome the §101 rejection.

Claims 14-21 were originally drawn to “an electronic mail client”. These claims have been amended to read “an electronic mail client system”. It is believed that the amendment to claims 14-21 overcomes this rejection.

Claims 22-27 were originally drawn to “a method of corresponding by electronic mail” and it is therefore believed that they already overcome the §101 rejection.

All claims also stand rejected under 35 U.S.C. §112. This rejection is founded on the §101 rejection above and it is therefore believed that the amendments referred to above overcome this rejection.

Claims 1-3, 5-23, and 25-27 stand rejected under 35 U.S.C. §102(e) over Quinn et al. In rejecting these claims, the Examiner discusses claims 8-13 and states that the other claims are “similar” and are rejected for the same reasons as claims 8-13.

As mentioned above, claims 8-13 are directed to an electronic mail system. More particularly, claim 8 provides for two clients having respective authoring/reading tools for creating and reading electronic mail messages. The respective authoring/reading tools create messages in respective different modes, each mode causing the messages to be displayed in a different manner.

The system described by Quinn et al. is not an electronic mail system. It is a database management system! The system is designed to manage large amounts of information which occur in both electronic and paper form. See, e.g. paragraphs 0004 through 0008. Throughout the Quinn specification, the term “messages” is used broadly to mean both paper and electronic messages. The term “electronic message” is used only three times, in the abstract and in paragraphs 0018 and 0052. The majority of the Quinn disclosure is concerned with scanning images of paper documents and integrating them with a database where they are indexed and associated with a particular transaction. The

single stated “object of the invention” is set forth in paragraph 0008 which is reproduced below for the Examiner’s convenience.

[0008] It is an object of the invention to overcome the above described limitations and others by providing a system and process for storing related documents, messages, and customer inquir[i]es as electronic images for retrieval in a controlled and secure manner to be used in connection with financial transactions, particularly international transactions such as transactions involving letters of credit, guarantees, import collections, export direct collections and export collections. [Emphasis added.]

The Examiner’s rejection is a little vague but the Applicant’s attorney will set out how the rejection is being interpreted by the Applicant. If the Applicant’s interpretation of the Examiner’s rejection is incorrect, the Applicant respectfully requests that the Examiner telephone the Applicant’s attorney so that corrective action can be taken before the Examiner acts on this amendment.

With reference to claim 8, it appears that Examiner believes that the claimed first and second electronic mail clients are taught in paragraph 0072 which is reproduced below for the Examiner’s convenience.

[0072] When a message is sent from User A to User B, a message from the Message Server Application for new messages (at step 384) is received through the Message Alert window. If [the] user does not wish to read the message, the system returns to the previous window (at step 390). If the user wishes to read the message, the user selects Read (at step 392) to display message.

This is not an email message as that term is used herein. It is a short text message that is sent within a closed system defined by the database. As stated in paragraph 0075, the message is limited to 2,000 characters which is not much more than this single page.

Quinn filed the application in 1996, a time when the terms “email” and “electronic mail” were well established. Yet Quinn did not to use either term even once in the application since his application does not relate to email. Significantly, this text message having 2,000 or fewer characters is not created with one tool and read with another tool which displays the message in a different manner as required by the claim. In both cases it is 2,000 characters or less of text. There is no suggestion in Quinn that the text message looks different when it is read as compared to when it is written.

The Examiner then states “create records, folders, 0050-0108”. It is not clear what part of claim 8 is being referred to in this quote. During a brief telephone conference on March 21, the Examiner kindly explained that this refers to the claimed first and second modes in the wherein clause of claim 8. The exact language of claim 8 is reproduced below with emphasis.

8. (original) An electronic mail system, comprising:

- a) a first electronic mail client having a first authoring/reading component for creating and reading electronic mail messages; and
- b) a second electronic mail client having a second authoring/reading component for creating and reading electronic mail messages, wherein said first authoring/reading component creates messages in a first mode and said second authoring/reading component reads messages in a second mode, each mode causing messages to be displayed in a different manner. [Emphasis added.]

It is respectfully submitted that the records and folders in Quinn are not electronic mail messages. The records are documents related to a particular transaction and the folders contain all documents related to the same transaction.

The Examiner then states “system controller, system administrator, checker such as authoring components 0085, 0090, 0105”. These paragraphs deal with creating and editing tables which are used to index documents in the database. No electronic mail messages are created in these paragraphs. The system controller, system administrator and checker are people, users of the database. Different users of the database have different jobs and different access privileges. As explained in paragraph 0048, after a document is scanned, it is indexed by an indexer and reviewed by a checker. The checker is assigned to a service representative by a system administrator. A system administrator can edit a table. A system controller can only approve or reject a table. However, no electronic mail message is involved. Therefore, the user access modes of Quinn cannot anticipate or suggest the authoring modes of the claimed email system.

The Examiner then states “edit fields and read only status, 0091, 0097.” The applicant believes that the Examiner is attempting to show the claimed modes which cause a message to be displayed in a different manner when it is read as compared to when it is authored. However, these paragraphs relate to entries being made in a database not to email. It is respectfully submitted that not every “electronic message” is an email or electronic mail. Voice mail is an electronic message. Fax mail is an electronic message. Television and radio may provide electronic messages. However, none of the electronic messages is an email or electronic mail. Similarly, the database information that is entered by one user and checked by another user might be considered an electronic message (simply because it is information in electronic form), but it is not an electronic mail or email.

Claim 9 depends from claim 8 and relates the authoring modes to customer and vendor, teacher and student, auctioneer and bidder, or doctor and patient. The Examiner cites paragraph 0072 of Quinn regarding claim 9, but that paragraph does not mention any of the roles listed in claim 9. It only mentions User A and User B and those terms are not mentioned anywhere else in Quinn.

Claim 10 depends from claim 8 and specifies that the mode of displaying a message is encoded in the message by the first authoring/reading component and determined by the second authoring/reading component when the message is read. The Examiner cites paragraphs 0056, 0066 and 0067 of Quinn regarding claim 10. Paragraph 0056 deals with where images are stored and how images are transferred from one location to another. Electronic mail is not an issue in paragraph 0056. Paragraph 0066 discusses the transfer of TIFF images from one location to another, where the data records associated with the images are stored and how the data and images are transferred. Electronic mail is not an issue in paragraph 0066. Paragraph 0067 deals with the transmission of data and images from one location to another. Electronic mail is not an issue in paragraph 0067.

Claim 11 depends from claim 8 and specifies that different tools are available for responding to an email depending on the mode it was authored in. The Examiner refers to paragraph 0124 of Quinn with regard to this claim. This paragraph has nothing to do with email, it has to do with a user browsing and searching the contents of a folder.

Paragraph 0124 of Quinn is also cited with regard to claim 12. Claim 12 depends from claim 8 and specifies that if a message is authored in the first mode, the viewer of the message (the email recipient) can see all of the information in the message and if it is authored in the second mode, the viewer can only see some of the information in the message. Although, paragraph 0124 of Quinn does state that the viewer of the folder contents can select to see all or some of the contents of the folder, this is not an email message and the user selects what to view. The user's view of the folder contents is not restricted by an authoring mode.

Claim 13 depends from claim 8 and specifies that the authoring mode controls how the viewer sees the information in the email organized. The Examiner refers to "read-only or read-write privileges" but does not cite a paragraph of Quinn. It is noted by the Applicant that different users of the Quinn database have different access privileges and some have read only and others can read and write. However there is no teaching in Quinn that these access privileges alter the way the user sees the information on the screen.

For the foregoing reasons, it is submitted that claims 8-13 are neither anticipated nor suggested by Quinn. The Examiner rejects claims 1-3 and 5-23 on the grounds that they are similar to claims 8-13. It is believed that the Examiner meant to say claims 1-3, 5-7, and 14-23. The Applicant respectfully submits that this is not a proper ground for rejection and that these claims are in many ways different from claims 8-13. If the

Examiner continues to reject claims 1-3, 5-7, and 14-23, it is respectfully requested that he explain his analysis of these claims so that the Applicant can respond to it.

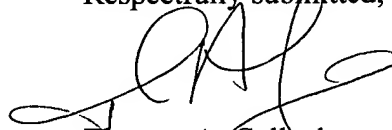
Claims 4 and 24 stand rejected under 35 U.S.C. §103(a) as obvious over Quinn in view of Shaffer. The Examiner does not specify where the incentive to combine these references is taught.

Claim 4 depends from claim 3 which depends from claim 1. Claim 24 depends from claim 22. Since the Examiner has not explained his rejection of claims 1, 3, or 22, the Applicant cannot respond to it in detail other than to say that the arguments made above regarding Quinn can apply to this rejection as well. Furthermore, since the Examiner did not say where the incentive to combine these references was found, the Applicant can only conclude that there is no incentive to combine the references other than the incentive invented by the Examiner.



In light of all of the above, it is submitted that the claims are in order for allowance, and prompt allowance is earnestly requested. Should any issues remain outstanding, the Examiner is invited to call the undersigned attorney of record so that the case may proceed expeditiously to allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'T. Gallagher', written over the printed name.

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